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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,790	01/20/2000	Raphaël Gorodetsky	995/46	3576

28765 7590 06/24/2004

WINSTON & STRAWN
PATENT DEPARTMENT
1400 L STREET, N.W.
WASHINGTON, DC 20005-3502

EXAMINER

LIU, SAMUEL W.

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/487,790

Applicant(s)

GORODETSKY ET AL.

Examiner

Samuel W Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 and 10-12, drawn to a polypeptide and pharmaceutical composition comprising the peptide, are classified in class 530, subclass 300 and class 514, subclass 2.
- II. Claims 7-9, drawn to an isolated polynucleotide, are classified in class 536, subclass 23.1.
- III. Claims 13-15, drawn to a peptide-conjugation composition wherein the peptide is conjugated on a solid surface, are classified in class 530, subclasses 402 and 300.
- IV. Claims 16 and 20-21, drawn to a cellular composition comprising the peptide, cells and a device, wherein the peptide is attached to a biomedical device which supports said cell, are classified in class 424, subclasses 93.7, 9.322 and 185.1, and class 530, subclass 300.
- V. Claims 17-19, drawn to a polymer composition comprising a plurality of subunits that comprises the peptide, and a plurality of linker moieties for linking the subunits, are classified in class 424, subclasses 70.1, 497, 9.322 and 9.411.

The inventions are distinct, each from the other because of the following reasons:

Inventions II is patentably distinct from Invention I, II, IV and V because of the materially different structures of the compounds claimed. The Invention II is drawn to polynucleotide while Inventions I is drawn to polypeptide and Invention III, IV and V drawn to the composition comprising a solid face and the peptide; the composition comprising cell and the peptide; and the composition comprising a plurality of subunits comprising the peptide. The biopolymers or/and the compositions of each invention would be expected to exhibit different physical and chemical properties, and are capable of separate manufacture or use.

Invention V and invention I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for

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patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the utility of a polymer composition does not necessary depend on the utility (e.g., the amino acid sequence of the peptide) of each separate peptide in the composition, and the subcombination has separate utility such as the distinct peptide of SEQ ID NO:1 or SEQ ID NO:2 or SEQ ID NO:3 which recognize distinct antibody.

Invention III and invention I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the peptide conjugated combination as claimed does not require the particulars of the subcombination as claimed because the utility of a peptide conjugate composition does not necessary depend on the utility (e.g., the amino acid sequence of the peptide) of each separate peptide in the composition (note that any peptide has ability of being conjugate to a solid support, and the subcombination has separate utility such as the distinct peptide of SEQ ID NO:1 or SEQ ID NO:2 or SEQ ID NO:3 which recognize distinct antibody.

Invention IV and invention I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the utility of a cellular composition does not necessary depend on the utility (e.g., the amino acid sequence or/and composition of the peptide) of each separate peptide in the composition (note that any peptide can be attached to a structural device by which cell that binds said cell is supported by said device structure, and the subcombination has separate utility such as the distinct peptide of SEQ ID NO:1 or SEQ ID NO:2 or SEQ ID NO:3 which recognize distinct antibody.

The peptide conjugation composition (Invention III), the cellular composition (Invention IV) and the polymer composition which is based on a plurality of subunits (Invention V) are distinct/different from each other because of the materially different

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structures of the compounds claimed, e.g., cell of Invention IV is not a component of Inventions III and V, and the plurality of the subunits of Invention V are not components of the Inventions III and IV. These compositions would be expected to exhibit different physical and biochemical properties, and are capable of separate manufacture or use.

Additional Election Under 35 USC 121

Irrespective of whichever group applicant may elect, applicant is further required under 35 US 121 (1) to elect a single disclosed peptide to which claims are restricted; and (2) to list all claims readable thereon as directed to the elected invention.

If any Group from Groups I - V is elected, applicant is required to elect one of peptide sequence (SEQ ID NO:1 or SEQ ID NO:2 or SEQ ID NO:3) because these amino acid sequences are structurally distinct from one another.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art shown by their different classification, art recognized divergent subject matter, separate search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Wei Liu, Ph.D. whose telephone number is (571) 272-0949. The examiner can normally be reached Monday-Friday 9:00 -5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Christopher Low can be reached on (571) 272-0951. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communication and (703) 305-3014 for the after final communication.



KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER

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A handwritten signature in black ink, appearing to read 'SWL', with a long horizontal stroke extending to the right.

Samuel W. Liu, Ph.D.

June 17, 2004